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			3626	

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Please find below and/or attached an Office communication concerning this application or proceeding.

Response to Amendment

1. In the amendment filed 11/14/05, the following has occurred: claims 2, 3, 7, 10, and 14 have been canceled and claims 1, 4-6, 11-13, 15, and 16 have been amended. Now, claims 1, 4-6, 8, 9, 11-13, and 15-17 are presented for examination.
2. The rejections under 35 U.S.C. 101 have been withdrawn by the Examiner based on changes made by Applicants to the claims.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claims 6, 8, 9, 11-13, and 15-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
5. Claims 6, 11, and 12 recite "the plurality of questions essentially consist of:..." However, the listed "questions" are in the form of actual questions such as "what happened," instructions to ask questions such as "ask questions about the incident that caused the injury," and statements that are neither actual questions nor instructions to ask questions such as "diagnosis." It is unclear whether the recited "questions" that are to be asked are intended to encompass just questions, instructions to ask questions, additional steps, etc. For examination purposes, the Examiner will interpret the questions to merely be a plurality of statements. However, appropriate correction is required to clarify the claimed subject matter.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fernberg, **Charting a course toward lower workers' comp claims** (hereinafter Fernberg, paragraphs numbered by Examiner) in view of DiRienzo, U.S. Patent No. 6,003,007.

8. As per claim 1, Fernberg discloses a method of optimizing a workers' compensation claims management process, which contains files relating to a workers' compensation claim of an injured or ill individual comprising the steps of: reviewing the workers' compensation claims management process to determine if best practices are being followed (see paragraphs 22 and 23, in particular, the disclosed consulting and benchmarking are types of reviewing to determine best practices); amending the workers' compensation claims management process by implementing the best practices into the workers' compensation claims management process (see paragraph 24); monitoring the amended workers' compensation claims management process to determine if the best practices are being followed (see paragraph 25, in particular the continuous reevaluation of the program); and closely monitoring a specific case within the workers' compensation claims management process to determine if the best practices are not being followed and to generate a report indicative thereof (see paragraphs 28-30, the Examiner interprets the "claims loss runs" to be a type of report).

9. Although Fernberg does teach certain best practices such as a report must include all known facts (see paragraph 29), Fernberg does not explicitly teach all of the items that are listed as best practices. However, listed items appear to be merely abstract conditions, such as

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“at the time of the review of the file the reserves should reflect an expected value based on the known facts,” that do not functionally relate to the method steps. Therefore, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *Cf. In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). In addition, it is respectfully submitted that the conditions that are listed under “best practices” are all old and well known in the art of workers compensation claims management processing.

10. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to list any data as the conditions for “best practices” because such data does not functionally relate to the recited method steps and merely labeling the data differently from that in the prior art would have been obvious matter of design choice. See *In re Kuhle*, 526 F.2d 553, 555, 188 USPQ 7, 9 (CCPA 1975).

11. In addition, Fernberg does not explicitly disclose the use of a computer for closely monitoring a specific case. However, DiRienzo teaches an insurance claims processing system that includes the feature of computer monitoring specific claims cases (see column 22, lines 25-36). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate computer hardware, as is standard in the industry, into method disclosed by Fernberg. One of ordinary skill in the art would have been motivated to incorporate a computer for the purpose of increasing the speed and efficiency of claims processing as is standard in the industry (see column 2, lines 38-41 of DiRienzo).

12. As per claim 5, Fernberg discloses the method of claim 1 as described above. Fernberg further discloses the best practices at includes timely and appropriate assignment of light duty work (see paragraph 36, in particular, the Examiner is relying on the disclosure of the modified duty program). Although Fernberg does not explicitly teach all of the listed best practices, such

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non-functional conditions do not distinguish the claimed invention from the prior art as described above with respect to claim 1.

13. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fernberg, **Charting a course toward lower workers' comp claims** (hereinafter Fernberg, paragraphs numbered by Examiner) in view of DiRienzo, U.S. Patent No. 6,003,007 and further in view of Hammond et al., U.S. Patent No. 5,712,984.

14. As per claim 4, Fernberg in view of DiRienzo teach the method of claim 1 as described above. Fernberg does not explicitly disclose the listed best practices. Hammond teaches a method for funding workers' compensation losses that at least includes the practice of properly documenting reserve changes within a file and reserve history (see column 14, lines 27-46). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate this feature into the method disclosed by Fernberg. One of ordinary skill in the art would have been motivated to incorporate this feature for the purpose of enhancing the ability of insurers and employers to more accurately budget and forecast (see column 2, lines 6-11 of Hammond).

15. In addition, although neither Fernberg nor Hammond explicitly teach all of the listed best practices, such non-functional conditions do not distinguish the claimed invention from the prior art as described above with respect to claim 1.

16. Claims 6, 8, 9, 11-13, and 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fernberg, **Charting a course toward lower workers' comp claims** (hereinafter Fernberg, paragraphs numbered by Examiner) in view of DiRienzo, U.S. Patent No.

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6,003,007 and Anthony, **Workers' compensation fraud** (hereinafter Anthony, paragraphs numbered by Examiner) and further in view of Ahmad, U.S. Patent No. 6,089,974.

17. As per claim 6, Fernberg discloses a method of optimizing a workers' compensation claims management process, which contains files relating to a workers' compensation claim of an injured or ill individual comprising the steps of: determining whether a claim is classified as a high risk (see paragraphs 34 and 38, in particular, determining whether there is potential for fraud is a type of "high risk" claim); conducting a three point interview within 72 hours of an injury (see paragraphs 28-31, in particular, the Examiner notes that Fernberg discloses conducting interviews with the employee, supervisor, and medical provider and discloses that it is favorable to conduct reporting within 48 hours); and monitoring a claim at periodic intervals (see paragraph 35).

18. Fernberg does not explicitly teach disclose the listed questions. Anthony discloses a method for avoiding workers' compensation fraud that includes at least asking questions about the incident that caused the injury (see paragraph 8). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate this feature into the method disclosed by Fernberg. One of ordinary skill in the art would have been motivated to incorporate this feature for the purpose of helping to further document inconsistencies and provide clues that could warrant a more detailed investigation (see paragraph 7 of Anthony). In addition, although neither Fernberg nor Anthony explicitly teach all of the listed questions, they appear to merely be abstract statements that do not functionally relate to the claimed method steps. Therefore, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see Cf. In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). In addition, it is

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respectfully submitted that these types of questions are all old and well known in the art of workers compensation claims management processing.

19. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to list any data as the questions because such data does not functionally relate to the recited method steps and merely labeling the data differently from that in the prior art would have been obvious matter of design choice. *See In re Kuhle*, 526 F.2d 553, 555, 188 USPQ 7, 9 (CCPA 1975).

20. Fernberg does not explicitly teach that a nurse conducts the interview. However, Ahmad teaches the practice of a nurse interviewing a patient for insurance claims processing purposes (see column 2, line 66 – column 3, line 9). It would have been obvious to one of ordinary skill in the art at the time of the invention to recognize the use of a nurse for conducting interviews in the method of Fernberg. One of ordinary skill in the art would have been motivated to do this for the purpose of taking advantage of medical professionals who know what questions to ask injured workers (see paragraph 31 of Fernberg).

21. Fernberg also does not explicitly disclose the use of a computer for monitoring a claim. However, DiRienzo teaches an insurance claims processing system that includes the feature of computer monitoring claims (see column 22, lines 25-36). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate computer hardware, as is standard in the industry, into method disclosed by Fernberg. One of ordinary skill in the art would have been motivated to incorporate a computer for the purpose of increasing the speed and efficiency of claims processing as is standard in the industry (see column 2, lines 38-41 of DiRienzo).

22. As per claim 8, Fernberg, Ahmed, Anthony, and DiRienzo teach the method of claim 6 as described above. Fernberg further discloses determining whether a claim is classified as

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high risk includes asking a supervisor a plurality of questions (see paragraphs 28 and 31, the Examiner notes that gathering information through questioning supervisors is a part of the process of determining the potential for fraud).

23. As per claim 9, Fernberg , Ahmed, Anthony, and DiRienzo teach the method of claim 6 as described above. Fernberg further discloses determining whether a claim is classified as high risk includes asking a medical professional a plurality of questions (see paragraphs 28 and 31, the Examiner notes that gathering information through questioning medical professionals is a part of the process of determining the potential for fraud).

24. As per claim 11, Fernberg, Ahmed, Anthony, and DiRienzo teach the method of claim 8 as described above. As described above, although neither Fernberg nor Anthony explicitly teach all of the listed questions such non-functional data does not distinguish the claimed invention from the prior art as described above with respect to claim 6.

25. As per claim 12, Fernberg, Ahmed, Anthony, and DiRienzo teach the method of claim 9 as described above. As described above, although neither Fernberg nor Anthony explicitly teach all of the listed questions such non-functional data does not distinguish the claimed invention from the prior art as described above with respect to claim 6.

26. As per claim 13, Fernberg, Ahmed, Anthony, and DiRienzo teach the method of claim 6 as described above. Claim 13 recites substantially similar additional limitations to those already addressed in claim 1 and, as such, is rejected for similar reasons as given above.

27. As per claim 15, Fernberg, Ahmed, Anthony, and DiRienzo teach the method of claim 6 as described above. Fernberg further discloses closely monitoring a specific case within the workers' compensation claims management process to determine if the best practices are not being followed if the claim is classified as high risk (see paragraphs 28-30, it is noted that

Fernberg discloses closely monitoring all claims and, therefore, also discloses closely monitoring "high risk" claims).

28. As per claim 16, Fernberg, Ahmed, Anthony, and DiRienzo disclose the method of claim 6 as described above. Fernberg further discloses closely monitoring a specific case within the workers' compensation claims management process to determine if the best practices are not being followed if the claim is classified as high risk (see paragraphs 28-30, it is noted that Fernberg discloses closely monitoring all claims and, therefore, also discloses closely monitoring "high risk" claims).

29. As per claim 17, Fernberg, Ahmed, Anthony, and DiRienzo disclose the method of claim 11 as described above. Fernberg further discloses closely monitoring a specific case within the workers' compensation claims management process to determine if the best practices are not being followed if the claim is classified as high risk (see paragraphs 28-30, it is noted that Fernberg discloses closely monitoring all claims and, therefore, also discloses closely monitoring "high risk" claims).

Response to Arguments

30. In the remarks filed 11/14/05, Applicant argues in substance that (1) independent claims 1 and 6 have been amended to include the close ended list form "essentially consist of"; (2) none of the applied prior art teaches the list of preferred practices as is presently claimed.

31. In response to Applicant's argument (1), the Examiner respectfully notes that the phrase "essentially consist of" excludes only those elements or steps that "materially affect the basic and novel characteristics" of the claimed invention (see *In re Herz*, 537 F.2d 549, 551-52, 190 USPQ 461, 463 (CCPA 1976). Since there is no clear indication in the specification of what would materially affect the basic and novel characteristics of the claimed invention, "essentially

consist of" will be construed by the Examiner as equivalent to "comprising" (See MPEP 2111.03).

32. In response to Applicant's argument (2), the Examiner has interpreted the listed best practices as merely non-functional conditions that do not functionally relate to the claimed steps. Therefore, the Examiner respectfully submits that it would have been an obvious matter of design choice to incorporate any particular conditions to be labeled as best practices.

Conclusion

33. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Luke Gilligan whose telephone number is (571) 272-6770. The examiner can normally be reached on Monday-Friday 8am-5:30pm.

34. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (571) 272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

35. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

2/6/06


C. LUKE GILLIGAN
PATENT EXAMINER